

### REMARKS

Claims 1-78 are pending in this application, with claims 1, 27, 34, 37, 47 and 72 being independent. Claims 4, 7-19, 20, 22, 31, 32, 34-36 and 38 have been previously withdrawn with traversal by applicant. Claims 1, 27, 37, 41, 43, 47, and 72 have been amended; claims 76-78 have been added; and claims 39 and 40 have been canceled. No new matter has been added.

Applicant reserves the right to further contest the Examiner's restriction requirement at a later date.

Applicant thanks the Examiner for participating in a telephonic interview with applicant's representative on January 23, 2007, the substance of which is incorporated in the following remarks.

Independent claims 1, 27, 37, 47, and 72 and their dependent claims 2, 3, 5, 6, 11-19, 21, 23-26, 28-30, 33, 39-46, 48-71, and 73-75 have been rejected as being anticipated by Staehlin (U.S. Patent No. 6,309,394).

Independent claim 1, as amended, recites a tissue cutting instrument that includes, among other features, an outer member and "an inner member received within the outer member, the inner member defining a passage for removal of cut tissue through the inner member" (emphasis added). Staehlin does not describe or suggest that indexing shaft 560, which the Examiner equates to the recited inner member, defines a passage for removal of cut tissue. Rather, as shown in Fig. 11, the shaft appears solid. For at least this reason, claim 1 and its dependent claims are patentable over Staehlin.

Independent claim 27, as amended, recites a method for cutting tissue that includes, among other features, "moving the cutter to end-on cut the tissue by shearing tissue between a surface of the cutter and another surface of the tissue cutting instrument" (emphasis added). Independent claim 37, as amended, recites a tissue cutting instrument that includes, among other features, "a cutter coupled to the inner and the outer members, the cutter including an extended portion extending distal of the terminal end, the cutter configured and arranged to perform end-on cutting by shearing tissue between a surface of the cutter and another surface of the tissue cutting instrument" (emphasis added). Staehlin does not describe or suggest that cutting tool 514

and support portions 516 and 532, the combination of which the Examiner equates to the recited cutter, moves to shear tissue between two surfaces. Rather, Staehlin only describes a single surface as being involved in the cutting action -- the surface of the rapidly spinning burr of the cutting tool 514. For at least this reason, claims 27 and 37 and their dependent claims are patentable over Staehlin.

Independent claim 47, as amended, recites a tissue cutting instrument that includes an outer member, an inner member received within the outer member, and "a cutter coupled to the inner and the outer members such that rotation of the inner member about an axis causes an off-axis movement of the cutter, the off-axis movement alone being capable of acting to cut tissue" (emphasis added). Staehlin does not describe or suggest the recited cutter having an off-axis movement alone being capable of acting to cut tissue. The Examiner argues that the off-axis positioning of the burr of the cutting tool 514 satisfies the limitation "the off-axis movement acting to cut tissue" because, absent this off-axis positioning to engage the cutting tool 514 with tissue, the cutting tool 514 would not be able to cut tissue. However, Staehlin neither describes nor suggests that the off-axis positioning of the cutting tool 514 alone is capable of cutting tissue without the spinning movement of the burr.

Independent claim 72, as amended, recites a tissue cutting instrument that includes, among other features, a cutter that includes a first shaft and a second shaft, "the first shaft protruding from a first surface of the cutter and the second shaft protruding from a second surface of the cutter, the first surface and the second surface being opposing surfaces located 180° apart from each other along an outer surface of the cutter" Staehlin's support housings 516 and 532, which the Examiner equates to the recited shafts, do not protrude from opposing surfaces located 180° apart from each other along an outer surface of the cutter. Rather, they are hemispherical shells that do not protrude from any surface. See Fig. 11. For at least this reason, claim 72 and its dependent claims are patentable over Staehlin.

Applicant submits that all claims are in condition for allowance.


Applicant does not acquiesce in the Examiner's characterizations of the art. For brevity and to advance prosecution, however, applicant may have not addressed all characterizations of

the art and reserve the right to do so in further prosecution of this or a subsequent application. The absence of an explicit response by the applicant to any of the Examiner's positions does not constitute a concession of the Examiner's positions. The fact that applicant's comments have focused on particular arguments does not constitute a concession that there are not other arguments for patentability of the claims. All of the dependent claims are patentable for at least the reasons given with respect to the claims on which they depend.

The fee in the amount of \$170 in payment of the for a one month Extension of Time fee for one extra claim in excess of twenty (20) is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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Roberto J. Devoto  
Reg. No. 55,108

Fish & Richardson P.C.  
1425 K Street, N.W.  
11th Floor  
Washington, DC 20005-3500  
Telephone: (202) 783-5070  
Facsimile: (202) 783-2331